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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,580	04/14/2004	Richard Paul Ejzak	29250-002031/US	6232
7590	01/27/2006		EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. Box 8910 Reston, VA 20195			BALAOING, ARIEL A	
			ART UNIT	PAPER NUMBER
			2683	
DATE MAILED: 01/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/823,580	EJZAK, RICHARD PAUL
	<b>Examiner</b> Ariel Balaong	<b>Art Unit</b> 2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Drawings***

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application (see attached PTO-948). Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 7 and 14 recite the limitation "the packet call controller" in line 3 of claim 7 and line 4 of claim 14. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10, 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by BOS et al (US 2004/0008669 A1).

Regarding claim 1, BOS discloses a method of transferring a packet switched call, the packet switched call being between a mobile station and an end point (abstract), the method comprising: establishing a bearer path if a call transfer request associated with the mobile station is received (abstract; paragraph 7-10, 52-54; call transfer request is initiated by the network or mobile user).

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the call transfer request is a call request including an identifier provided by the mobile station that identifies the call request as a call transfer request (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the identifier is a public identifier provided for use by mobile stations to request call transfer of an ongoing packet switched call (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the identifier is a

unique identifier associated with the mobile station for use in requesting call transfer of an ongoing packet switched call (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the unique identifier is a public telecommunication number assigned to the mobile station for use in the second network (paragraph 52-54; MSISDN number).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the call request is a SIP INVITE request (paragraph 52, 74; invitation is sent to the gateway using SIP protocol after SIP REFER message).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the establishing step comprises: sending a call control request to the end point requesting agreement to transition the packet call controller from a call control agent for a first call control path from the first network to the end point to a call control agent for a second call control path from the second network to the end point (paragraph 65, 82; server 2 instructs terminating unit that all data should be sent to gateway 7).

Regarding claim 8, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the establishing step further comprises: setting up the bearer path at the packet call controller as the call control agent for the second call control path (paragraph 65, 82).

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the control request is a SIP re-INVITE request (paragraph 82).

Regarding claim 10, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the call transfer request is a SIP INVITE request (paragraph 52, 74; invitation is sent to the gateway using SIP protocol after SIP REFER message).

Regarding claim 16, BOS discloses a method of transferring a packet switched call carried over a first network to a circuit switched call carried over a second network (abstract), comprising: sending a call transfer request associated with a mobile station involved in the packet switched call if a call origination request for a circuit switched call is received (abstract; paragraph 7-10, 52-54; call transfer request is initiated by the network or mobile user).

Regarding claim 17, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the call transfer request is a call request including an identifier provided by the mobile station that identifies the call request as a call transfer request (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 18, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the identifier is a public identifier provided for use by mobile stations to request call transfer of an ongoing

packet switched call (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the identifier is a unique identifier associated with the mobile station for use in requesting call transfer of an ongoing packet switched call (paragraph 52-54; invitation is sent after obtaining number using SIP REFER).

Regarding claim 20, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the unique identifier is a public telecommunication number assigned to the mobile station for use in the second network (paragraph 52-54; MSISDN number).

Regarding claim 21, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the call request is a SIP INVITE request (paragraph 52, 74; invitation is sent to the gateway using SIP protocol after SIP REFER message).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over BOS et al (US 2004/0008669 A1) in view of KALLIO et al (US 2004/0190498 A1).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the establishing step comprises: receiving a SIP INVITE request (paragraph 52-54, 65, 82); determining whether the SIP INVITE request requests transfer of the packet switched call on the first network to a circuit switched call on the second network (paragraph 52-54, 65, 82); and setting up the bearer path between the end point and the second network when the determining step determines that the SIP INVITE request does request transfer (paragraph 52-54, 65, 82). However, BOS does not expressly disclose wherein the SIP INVITE includes a request URI; and wherein the determination is based on the request URI. KALLIO discloses wherein the SIP INVITE includes a request URI; and wherein the determination is based on the request URI (paragraph 50-52). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify BOS to include a request URI within the SIP INVITE, as taught by KALLIO, as both systems relate to the transferring of packet based communication to

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circuit based communication. This is beneficial in that as the URI can be used to determine all participants of the call.

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, BOS does not expressly disclose wherein the determining step determines that the SIP INVITE request does request transfer when the Request URI is a public identifier provided for use by mobile stations to request call transfer of an ongoing packet switched call. KALLIO discloses wherein the determining step determines that the SIP INVITE request does request transfer when the Request URI is a public identifier provided for use by mobile stations to request call transfer of an ongoing packet switched call (paragraph 50-52). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify BOS to include a request URI within the SIP INVITE, as taught by KALLIO, as both systems relate to the transferring of packet based communication to circuit based communication. This is beneficial in that as the URI can be used to determine all participants of the call.

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, BOS does not expressly disclose wherein the determining step determines that the SIP INVITE request does request transfer when the Request URI is a unique identifier associated with the mobile station for use in requesting call transfer of an ongoing packet switched call. KALLIO discloses wherein the determining step determines that the SIP INVITE request does request transfer when the Request URI is a unique identifier associated with the mobile station

for use in requesting call transfer of an ongoing packet switched call (paragraph 50-52). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify BOS to include a request URI within the SIP INVITE, as taught by KALLIO, as both systems relate to the transferring of packet based communication to circuit based communication. This is beneficial in that as the URI can be used to determine all participants of the call.

Regarding claim 14, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses wherein the establishing step further comprises: sending a SIP re-INVITE request to the end point requesting agreement to transition the packet call controller from a call control agent for a first call control path from the first network to the end point to a call control agent for a second call control path from the second network to the end point (paragraph 65, 82); and wherein the setting up step is performed by the packet call controller as the call control agent for the second call control path (paragraph 65, 82).

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. BOS further discloses further comprising: serving as a proxy for the packet switched call prior to the receiving step (paragraph 50, 64; P-CSCF); accumulating information regarding the packet switched call while serving as the proxy (paragraph 52-54, 65; detection of a continuation problem inherently requires accumulating information regarding the packet switched call); and wherein the determining step determines that the SIP INVITE request does request transfer based on at least the accumulated information (paragraph 52-54). However, BOS does not

expressly disclose wherein the URI is used for determination of transfer request. KALLIO discloses wherein the URI is used for determination of transfer request (paragraph 50-52). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify BOS to include a request URI within the SIP INVITE, as taught by KALLIO, as both systems relate to the transferring of packet based communication to circuit based communication. This is beneficial in that as the URI can be used to determine all participants of the call.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

EJZAK (EP 1182900 A1) – Handover of wireless calls between systems supporting circuit and packet call models

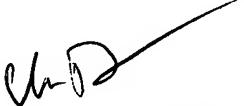
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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